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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,643	04/06/2001	Brian J. Roberts	12406/102	5505
7590	08/02/2006		EXAMINER	
ANDREW L REIBMAN, ESQ KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			MCCULLOCH JR, WILLIAM H	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/828,643	ROBERTS, BRIAN J.
	Examiner	Art Unit
	William H. McCulloch Jr.	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 March 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 38-42 and 44-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 38-42 and 44-63 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 June 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/17/2006.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. This action is in response to amendments received 3/3/2006. The application has claims 38-42 and 44-63 pending, with claims 38, 44, 45, and 51 currently amended, and claim 43 cancelled.

Information Disclosure Statement

2. The information disclosure statement (IDS) with mailroom date 1/17/2006 was filed in compliance with the provisions of 37 CFR 1.97-1.98. Accordingly, the examiner has considered the information disclosure statement.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 38-42 and 44-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,944,606 to Gerow in view of U.S. 5,112,050 to Koza et al. ("Koza"), and in further view of U.S. RE35,864 to Weingardt. This rejection was set forth in a previous action and is maintained herein.

Gerow discloses a gaming system (100) comprising game ticket (10, 10') for the play of a jackpot game together with a separate ticket-based lottery game, which comprises an indicia for use in the play of a lottery game, and a machine-readable ticket identifier (22') for use in the play of a progressive jackpot game, 4:49-51. System 100 includes a control system 120 to which each of the units are operatively connected,

such as by a serial cable 122. Gerow discloses that many state lotteries fall into the progressive category because the prize increases over time as more players participate (see at least 1:45-55).

In the preferred embodiment, control system 120 is an IBM compatible computer running software known as Progressive Pull-Tab Version 1.3, produced by Paradise Valley Electronics, of Moscow, Id., that allows the control system to communicate with each of the dispensing units, although any suitable software could be used. Control system 120 monitors the quantity of pull-tab cards dispensed by the dispensing units. In the preferred embodiment, each unit signals the control system when a player purchases cards and when a card is dispensed.

Also in the preferred embodiment, the control system is physically separated from the dispensing units, but it could just as well be incorporated in one of the dispensing units, or each unit could have its own control system. As an additional alternative, cards could be directly sold and distributed by a cashier or operator.

System 100 also includes a jackpot display 130 operatively connected to the control system to display a jackpot value. In the preferred embodiment, the software on the control system keeps track of the jackpot value and sends information to the jackpot display. The redemption value of the jackpot card is determined by the jackpot value.

In the preferred embodiment of the invention, the jackpot is set to a predetermined value at the beginning of the game, that is, when a new set of cards is loaded into the system to be dispensed. As the control system receives signals

indicating sale of cards, it increases the jackpot value. For instance, the jackpot value may be incremented by five-percent of the price of each card, as they are sold.

Although the jackpot value is incremented for every card sale in the preferred embodiment, it could be incremented less frequently, or additionally on occurrence of other events. For example, the jackpot could be incremented once for every five card sales or once every fifteen minutes, or both. In the preferred embodiment, the jackpot value is incremented by and stored in software in the computer, but the jackpot could be as simple as a mechanical counter that was incremented for every ticket sale or some fraction thereof. Players receiving winning cards before or after the jackpot card is dispensed are able to redeem them for the predetermined value of the card. Thus, although the jackpot may have been awarded, the play of the game may continue until all the cards are dispensed, with the draw for players being the remaining winning cards. Alternatively, the game could be stopped as soon as the jackpot card is dispensed, or after all winning cards have been redeemed.

In the preferred embodiment, the control system may be connected to a large number of dispensing units. The control system, using identification codes and software is able to segregate these dispensing units into various groups of one or more machines. Each group can then be used to play an independent game. Thus, if there are twenty-one dispensing units connected to the control system, they may be divided into two groups of five, a group of ten, and a group of one. Each group would then have an independent jackpot display and separate gaming set. Preferably, of course, the

group with ten dispensing units would be used with a gaming set having ten times as many cards as the gaming set for the group with one dispensing unit.

In a progressive game it can be desirable to link multiple machines, and therefore more players, in a single game because the associated potential jackpot will generally go up with the number of cards making up the game. In the preferred embodiment, the operator is provided with complete flexibility to control the parameters of the jackpot using the control system. In particular, the operator of the game can, using the software running on the control system, select the initial value of the jackpot, i.e., \$0 or \$500. In the preferred embodiment, the operator is also able to select an increment percentage for each sale of a pull-tab card. Such values might range from a few percent to 25 percent or more. The values are selected to make the game appeal to players and maintain a profit for the operator. Thus, a large initial jackpot value may be used in conjunction with a smaller percentage increment. On the other hand, a large percentage increment may be used with a small initial value. The control system is also able to track total sales and various auditing data from the dispensing units.

Additionally, a card reader may be internal to the dispenser and simply read the card or backing strip prior to expelling the pull-tab card. Preferably, the card reader is incorporated in the dispensing unit so that the dispensing unit can be configured to provide game credits for winning cards, thereby allowing the play to continue to play. Alternatively, the dispensing unit could issue cash or vouchers redeemable with a cashier for winning cards. As an additional alternative, the pull-tab cards could be dispensed by a dispensing unit and a separate card-reading unit, similar to dispensing

unit 102' above but without the dispensing capability, could be used to redeem the cards. As described in figure 8 and column 6 that after dispensing a card from the machine the machine will display to the recipient of the card if the card is a winner.

Gerow does not disclose a multi-jurisdictional game and the communication specifics with the central computer. Instead, Gerow discloses that many state lotteries fall into the progressive category because the prize increases over time as more players participate and the control system is also able to track total sales and various auditing data from the dispensing units. This would provide motivation for one of ordinary skill in the art to find other progressive game systems where auditing data may be exchanged and the progressive system more fully explained.

In an analogous system Koza teaches a lottery system comprising a memory (15) for holding coded values, 4:50-62. Koza further teaches a comparator for comparing coded value to indicate (16) a match condition, 4:50-62. Upon a matching condition, Koza discloses using audio/visual alarm to provide the indication, 4:50-62. FIG. 6 is a diagram showing a selection of a value by the player, an assignment of the selected value to the ticket by an impregnating device, and a recording of such selection at a central information repository. In FIG. 6, a player presents apparatus 70 (i.e. the game ticket) at the retail location. The apparatus 70 is connected to an impregnating device 71 via a connector 76 of the apparatus 70 and connector 77 of the impregnating device 71. A keyboard 72 coupled to the impregnating device 71 allows the entry of the values of the game desired by the player. This keyboard may be operated by either a player or a clerk, and be part of a vending machine, and could further be with a coin

slot. The impregnating device 71 causes signals to be created and transmitted to the apparatus 70 and entered into a memory resident on the apparatus 70. The EEPROM of the microprocessor controller chip 57 will provide that function when controller chip 57 is used in the apparatus 70.

Appropriate validation and security codes accompany the game values to assure the validity of the game values in event of a win. Before a prize is paid, the stored game values of the player must qualify for a prize given the broadcast values and, in addition, the stored game values must agree with an encrypted version of the stored game values in the apparatus, as well as with a record 73 of the stored game value and an additional validation code created at the time of issuance of the game value, retained at a central site operated by the sponsor of the game. It is appreciated that the earlier described apparatus of FIGS. 4 and 5 can be readily used to provide apparatus 70. It is to be noted that it is also possible that the player could choose to allow the impregnating device to randomly generate the new game values for his apparatus (i.e. the easy pick) and impregnate such new random values in his apparatus. Also the new game values could be supplied via a separate paper game ticket, in the form of an optically scan-able printed bar code, optically readable printed characters, information encoded on a magnetic strip or other such means. See at least columns 10-11.

The impregnating device 71 creates a record 73 of issuance of the game value selected by the player. The record of issuance would typically be a signal sent via dedicated telephone lines to a central computer maintained by the sponsor of the lottery or promotional game; however, this record of issuance could also be in the form of a

printed paper record or a magnetic memory device (such as a floppy disk). This signal contains the game values selected, as well as the time and date of issuance and other administrative information appropriate to the game. Finally, it is possible for the game values to be generated by the controller chip 57 itself using a program. This program would generate a sequence of game values using a pseudo-random algorithm. Such pseudo-random algorithms are well known in the prior art and are capable of generating a sequence of seemingly random, seemingly unpredictable, and seemingly unrelated game values. However, in fact, the entire sequence of such seemingly random values is generated in an entirely deterministic way by the mathematical algorithm and thus capable of precise verification of validity in event of a win. Then, as each new winning value is broadcast, the apparatus determines whether the newly computed, seemingly random stored value in the apparatus is a winner in the game given the broadcast values. Thus, the stored values of the game in the ticket apparatus may arise in any one of the three ways, namely, created at the time of manufacture, created as a result of a selection and request initiated by the player, or internally created by the microprocessor controller in the apparatus just prior to the broadcast of the winning values. Koza further discloses the use of a modem 6:63 and a printer for printing tickets and receipts column 2.

An analogous reference to Weingardt discloses that a lottery type game can be used in a multi-jurisdictional game environment and advantageously discloses the history and use of pari-mutuel pools including seeding pools and secondary (or shadow) for additional jackpots associated with the same game. Weingardt teaches a gaming

system using a progressive jackpot to award players. Weingardt further teaches providing funding of future pools by setting aside into future pools portions of wagers made by current players (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the communications and encryptions taught by Koza with the multi-jurisdictional and seeding/shadow in relation to the second prize pool teaching of Weingardt, using the motivation provided by Gerow disclosing that many state lotteries fall into the progressive category because the prize increases over time as more players participate and the control system is also able to track total sales and various auditing data from the dispensing units. This would provide motivation for one of ordinary skill in the art to find other progressive game systems where auditing data may be exchanged and the progressive system more fully explained.

Response to Arguments

5. Applicant's arguments, see p. 10-11 of Remarks filed 3/3/2006 with respect to 35 U.S.C. 112, have been fully considered and are persuasive. The rejection of claims 59-60 under 35 U.S.C. 112 has been withdrawn. The rejection of claim 50 is withdrawn in view of applicant's amendment.
6. Applicant's arguments filed 3/3/2006 have been fully considered but they are not persuasive.

Applicant argues that Gerow teaches a single pull-tab game with a single card set, rather than a plurality of such games. Applicant appears to argue that the instant claims are directed toward a plurality of *different* games. However, the examiner found

no such limitation to support this assertion. For example, cited claim 38 states in pertinent part, "a plurality of scratch-off instant games each available in at least one of the plurality of jurisdictions". This limitation requires only a plurality of games. Clearly, Gerow teaches multiple embodiments of pull-tab and progressive pull-tab games. The examiner notes that Gerow also teaches multi-play pull-tab cards, which would constitute more than one game (see at least 4:33-48 and fig. 7).

Applicant contends that Gerow's teaching about progressive state lotteries is only applicable to "numbers games", which are future draw lottery games (e.g. Powerball, Lotto, etc.). While the examiner agrees that the cited portion of Gerow (1:50) is directed toward future draw games, it is clear that Gerow's entire inventive concept is centered on applying what was known in future draw games to instant win games. Applicant is directed to Gerow's summary of the invention in column 2.

On page 13 of Remarks, applicant contends that Gerow does not teach or suggest a future draw lottery ticket. This statement appears to conflict with applicant's previous argument that Gerow only teaches future draw lottery games. Regardless, Gerow contemplates both instant- and future win games, as explained above.

Applicant argues that the references do not teach starting to accumulate a new prize pool upon the detection of the dispensing of an additional ticket after the detection of said winner. The examiner notes that Gerow teaches such a limitation in the following: "In the preferred embodiment, the software on the control system keeps track of the jackpot value and sends information to the jackpot display. The redemption value of the jackpot card is determined by the jackpot value. In the preferred embodiment of

the invention, the jackpot is set to a predetermined value at the beginning of the game, that is, when a new set of cards is loaded into the system to be dispensed. As the control system receives signals indicating sale of cards, it increases the jackpot value" (5:48-51, emphasis added); and "Players receiving winning cards before or after the jackpot card is dispensed are able to redeem them for the predetermined value of the card. Thus, although the jackpot may have been awarded, the play of the game may continue until all the cards are dispensed, with the draw for players being the remaining winning cards. Alternatively, the game could be stopped as soon as the jackpot card is dispensed, or after all winning cards have been redeemed" (6:57-66, emphasis added).

Applicant contends that the cited references do not teach randomly determining whether a ticket is a winning ticket at the time the ticket is dispensed. The examiner notes that Koza teaches it is well known in the art that "the selection of the winning ticket(s) can be achieved prior to, during, or after distributing the tickets to the players" (1:22-32). Koza also teaches randomly determining ticket numbers, such as relating to the impregnating device described above. Regardless, determining whether the ticket is a winning ticket *at the time of dispensing* lacks criticality, and determining could be done equally well at a later time.

In view of the above explanation, the previous rejection is deemed proper.

Citation of Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. 6,887,152 to Stanek teaches a lotto game having a jackpot

prize level and at least one subordinate prize level and which is played simultaneously in a plurality of jurisdictions or countries.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William H. McCulloch Jr.
Examiner
Art Unit 3714
7/26/2006


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